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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/618,382	07/14/2003	Robert M. Bensman	VEA.P.2	4890

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EXAMINER

BRINEY III, WALTER F

ART UNIT	PAPER NUMBER
2644	

DATE MAILED: 11/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/618,382

Applicant(s)

BENSMAN, ROBERT M.

Examiner

Walter F Briney III

Art Unit

2644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 03 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

- 1. Claims 1-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bensman et al. (US Patent 5,920,623) in view of Mastro et al. (US Patent Application Publication 2002/0041666) in view of Jesurum et al. (US Patent 5,430,792) and further in view of Roybal (http://www.mosaixusergroup.com/avya_SSB116.htm).**

Claim 1 is limited to *an apparatus interposed in a telephone line for defeating predictive dialing telemarketing systems*. The inventor, Bensman, has supplied reference to their previous patent (US 5,920,623). The apparatus therein includes all physical elements of the current invention, with the exception that the signal generator only produces a 914 Hz signal for defeating a telemarketer's incoming call. This is different than *generating energy associated with an answering machine greeting*. Therefore, the previous patent to Bensman anticipates all limitations of the claim with the exception of *generating energy associated with an answering machine greeting*.

Mastro teaches a method and apparatus to eliminate unwanted predictive dialer initiated telemarketing calls by generating multiple tones in response to an incoming call. See Abstract. Mastro teaches that the tones produced should not be limited to SIT, but any type and number of tones that will convince the telemarketer's predictive

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dialer that the intended recipient's telephone has an abnormal operating condition. See paragraph 22. Thus, one of ordinary skill in the art would need to determine what types of tones and/or signals a predictive dialer is sensitive to.

Jesurum teaches an automated telephone calling system. See Abstract. The calling system is indicated as being responsive not to SIT as suggested by Bensman, but by the type of voice energy it receives. It makes an estimate as to whether a voice received from its intended recipient comprises a live, human voice or a recorded message. Therefore, the single-tone generator of Bensman would not defeat the system of Jesurum. See Abstract and column 2, lines 9-22. As further evidence, an article published by Roybal suggests that the TeleZapper, which is known to generate a single SIT, is ineffective at stopping the Mosaix predictive dialing system. It would have been obvious to one of ordinary skill in the art at the time of the invention to generate multiple tones as taught by Mastro with energy and duration representative of an answering machine as taught by Jesurum for the purpose of defeating predictive dialers that are not sensitive to SIT, such as those taught by Jesurum and Roybal.

Claim 2 is limited to *the apparatus for defeating predictive dialing telemarketing systems according to claim 1*, as covered by Bensman in view of Mastro, Jesurum, and Roybal. The apparatus taught by Bensman has two embodiments. In the first, the signal generator continuously generates the signaling tone (i.e. *wherein said audio energy generator continually produces said signal*). See column 4, lines 48-51. Therefore, Bensman in view of Mastro, Jesurum, and Roybal makes obvious all limitations of the claim.

Claim 3 is limited to *the apparatus for defeating predictive dialing telemarketing systems according to claim 1*, as covered by Bensman in view of Mastro, Jesurum, and Roybal. In the second embodiment of Bensman, the signaling tone is generated in response to the controller (i.e. *wherein said controller is interconnected with said audio energy generator, said controller activating said audio energy generator to produce said signal upon receipt of said incoming call*). See column 4, lines 51-55. Therefore, Bensman in view of Mastro, Jesurum, and Roybal makes obvious all limitations of the claim.

The method steps recited in claims 4-6 are inherently performed by the apparatus defined in claims 1-3, therefore, the claims are rejected for the same reasons.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter F Briney III whose telephone number is 703-305-0347. The examiner can normally be reached on M-F 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Forester W Isen can be reached on 703-305-4386. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WFB
10/25/04



XU MEI
PRIMARY EXAMINER